REMARKS

Entry of the amendment is requested.

Figure 3 is amended to refer to SEQ ID NOS: 1 and 8. The specification is amended.

Turning to objections, page 2 is amended, but there are no gaps at page 10.

Please review the text. Note, that the material of line 3 follows logically from line 2. (This is what applicants assume the Examiner meant but it is only an assumption, since line numbers were not provided).

With respect to the rejection under 35 U.S.C. § 112, second paragraph, amended claim 32 does not present hybridization language. The rejection is moot.

With respect to the double patenting rejections, terminal disclaimers are presented herewith, disclaiming the term of any patent beyond 6,525,177, and 6,274,145. The underlining is provided because the Office Action refers alternatively, to 6,525,177 and 6,524,177. This confuses the issue, but it is believed that 6,525,177. Clarification should follow from the Examiner.

With respect to the written description rejection (except for claim 40), amended claim 32 does not present the language objected to, and thus the rejection is moot.

With respect to claim 40, the term "tumor rejection antigen" is art recognized and well known. See, e.g., **[NDH TO PROVIDE]**. A specification need not teach, and preferably leaves out that which is well known in the art. Hybritech, Inc. v. Monoclonal Antibodies, Inc., 231 USPQ 75,81 (Fed. Cir. 1986).

As claim 32 stands, none of what the Examiner says at page 13:

> "Thus the claims encompass portions of proteins encoded by numerous variants of the polynucleotide of SEQ ID NO: 1, with unknown structure and function."

is true, and the argument advanced thereafter, at pages 13-16 is moot.

With respect to the lack of enablement rejection at page 16, the Examiner states:

> "(T)he specification, while being enabling for an isolated protein consisting of an immunoreactive portion of a

protein encoded by the nucleotide sequence of SEQ ID NO: 1..."

This is how claim 32 reads, verbatim. Hence, this rejection cannot stand, as the claims require.

With respect to the rejections of claim 33-35, this is not understood. There are only two ways a peptide can provoke an immune response, i.e., be an immunoreactive portion of a protein. It is required that the molecules bind to either a Class I or a Class II, MHC molecule. These are presented on T cells. The molecules are large enough to generate antibodies. Further, if the Examiner doubts enablement for, e.g., SEQ ID NOS: 4, 5, and 6, why does claim 41 not stand as included in the rejection of claims 33-35? The Examiner questions the statement that SEQ ID NOS: 4, 5, and 6 were strong stimulators of CTLs. Please see example 12, pages 24-25, which sets out the experiment which explains exactly how this was determined. The examples in a specification must be accepted as true, unless a factual basis is given for the challenge. While the Examiner has cited references, non have been applied to Example 12.

With respect to the language at page 26 of the action, applicants are confused because the Examiner presents, and rejects a claim that is not presented. The bold language at page 26, point 2, is not found in the claims. Please explain the basis for rejecting a claim not presented.

Withdrawal of the rejections is believed proper and is urged.

Respectfully submitted,

By _____

Norman D. Hanson
Registration No.: 30,946
FULBRIGHT & JAWORSKI L.L.P.
Attorney for Applicant

666 Fifth Avenue
New York, New York
(212) 318-3000
(212) 318-3400 (fax)

Enclosures: Terminal Disclaimer
Amended Figure 3

Page 2, lines 1-6:

This application filed December 9, 2000, now U.S. Patent No. 6,525,177, which is a divisional of application 09/751,798, is a continuation in part of Serial No. 08/937,263, filed September 15, 1997, now U.S. Patent No. 6,274,145, which is a continuation in part of Serial No. 08/725,182, filed October 3, 1996, now U.S. Patent No. 5,804,381. Both of these applications are incorporated by reference.

Page 6, lines 1-2:

Figure 3 shows potential sites for modification of the deduced amino acid sequence of NY-ESO-1. The amino acid sequence is set forth at SEQ ID NO: 8. The nucleotide sequence is set forth at SEQ ID NO: 1.